

TMH/DAG:lam 03/25/04 259367
PATENT

Attorney Reference Number 6395-57049
Application Number 09/763,397

REMARKS

Claims 1, 3-6, 10 and 13 are pending in this application. No claim or other amendments are made herein. In light of the following arguments, reconsideration of the pending claims is requested.

February 11, 2004 Interview Summary:

Applicants thank Examiner Ford for providing a summary of the February 11, 2004 telephone call from the Examiner to Applicants' representative, Debra A. Gordon. In that telephone call, Examiner Ford offered to (i) cancel all claims except claim 3 by Examiner's Amendment and issue a Notice of Allowance for claim 3, or (ii) withdraw the final rejection of the application and issue a non-final Office action containing new obviousness rejections directed to all pending claims except claim 3. Applicants elected to accept option (ii), and their representative, Debra A. Gordon, delivered this decision to Examiner Ford by telephone call on February 12, 2004.

March 3, 2004 Telephone Conference:

Applicants also thank Examiner Ford for the courtesy of a telephone conference with their representative, Debra A. Gordon, on March 3, 2004. During the telephone conference, the Patent Office's prior acknowledgment (in Paper No. 18) that the Gilbert *et al.* reference (*Nature Biotech.*, 15:1280-1284, 1997) had been overcome by Applicants' Rule 131 Declaration, mailed June 11, 2002 ("Declaration"), was discussed. The Examiner was concerned that the Declaration overcame Gilbert *et al.* only in connection with rejections issued under 35 U.S.C. §102 and was inapplicable to the present rejections under 35 U.S.C. §103. Applicants' representative explained that the Declaration is sufficient to remove Gilbert *et al.* as prior art under both §102 and §103. The Examiner suggested that Applicants respond to the pending Office action and refer to the June 11, 2002 Rule 131 Declaration. It is believed that this Response addresses the helpful suggestion of Examiner Ford.

Allowed Claim:

Applicants thank Examiner Ford for allowing claim 3.

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January 15, 2004 Amendment:

Applicants acknowledge that the after final amendment, filed January 15, 2004, was entered.

Rejections Withdrawn:

The Office action states (at page 2, ¶3) that all of the "rejections set forth in the Office action mailed October 15, 2002 (sic) have been withdrawn". Applicants note that the date of the immediately preceding Office action was October 15, 2003. Thus, Applicants believe all of the rejections set forth in the Office action mailed October 15, 2003 have been withdrawn.

Notwithstanding paragraph 3(b) of the Office action (which identifies claims 1, 3, 5-6, and 13), Applicants further note that claims 1, 3-6 and 13 were previously rejected under 35 U.S.C. §103(a) in paragraph 4 of the October 15, 2003 Office action. Thus, Applicants believe that rejection of claims 1, 3-6 and 13 (including claim 4) under 35 U.S.C. §103(a) has been withdrawn.

Accordingly, Tine *et al.* (*Infect. Immun.*, 64:3833-3844, 1996) has been overcome as the basis for §102(b) rejections of claims 1, 3, 5-6, 10, and 13; and Tine *et al.* and Schmitt *et al.* (*Mol. Biol. Rep.*, 18:223-230, 1993) have been overcome as the collective basis for a §103(a) rejection of claims 1, 3-6 and 13.

Claim Rejections under 35 U.S.C. §103:

Claims 1, 5-6, and 13 (paragraph 4 of the Office action) and claims 1 and 10 (paragraph 6 of the Office action) have been rejected under 35 U.S.C. §103(a) as allegedly being obvious in light of Gilbert *et al.*, in view of Tine *et al.* In addition, Claim 4 has been rejected under 35 U.S.C. §103(a) (paragraph 5 of the Office action) as allegedly being obvious in light of Gilbert *et al.*, in view of Tine *et al.*, and further in view of Schmitt *et al.* These rejections are addressed together because the same considerations apply equally to all three rejections. Applicants traverse each rejection for the reason stated below.

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Gilbert *et al.* is not available as prior art against the claims recited in the present application. The Patent Office has acknowledged that Applicants' June 11, 2002 Rule 131 Declaration was sufficient to overcome Gilbert *et al.* It is not relevant that Gilbert *et al.* was previously overcome in connection with an earlier-issued rejection under 35 U.S.C. §102. As stated in MPEP §2141.01, "an obviousness rejection . . . can be overcome by swearing behind the publication date of the reference by filing an affidavit or declaration under 37 C.F.R. 1.131." Thus, Gilbert *et al.* is not properly cited in the present obviousness rejections.

Because Gilbert *et al.* cannot be properly cited, the foregoing obviousness rejections are based on Tine *et al.* alone (*i.e.*, claims 1, 5-6, 10, and 13) or upon Tine *et al.* in combination with Schmitt *et al.* (*i.e.*, claim 4). As discussed above in the section entitled "Rejections Withdrawn," the Office action admits that Tine *et al.* (even in combination with Schmitt *et al.*) cannot support an obviousness rejection of, at least, claims 1, 4-6 and 13. Thus, the Patent Office offers absolutely *no support* for the obviousness rejection of, at least, claims 1, 4-6, and 13. In the absence of any support for the rejection of these claims, the rejection should be withdrawn.

With regard to claim 10, Tine *et al.* alone does not teach all of the elements of the rejected claims; thus, no *prima facie* case of obviousness has been established, and the rejection of claim 10 should also be withdrawn.

In light of the foregoing arguments, Applicants request that all of the rejections under 35 U.S.C. §103(a) be withdrawn.

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CONCLUSION

It is respectfully submitted that the present claims are in a condition for allowance. If it may further issuance of these claims, the Examiner is invited to call the undersigned patent attorney at the telephone number listed below.

Respectfully submitted,

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